REMARKS

In the Office Action, the Examiner noted that the claims 1-52 are pending in the application, **that claims 11, 14, 15, 25-29 and 43-52 are allowed,** and that the claims 1-10, 12, 13, 16-24 and 30-42 are rejected over various prior art references. Applicant graciously acknowledges the Examiner's indication of allowable subject matter.

By this response, no claims have been amended. Thus, claims 1-52 remain pending in the application. Applicant respectfully traverses the rejections for the reasons indicated below.

Applicant would like to initially inform the Examiner that Stebbings (U.S. Patent Number 6,636,689) is not prior art under 35 U.S.C. 102(e) or 103(a) because Stebbings' earliest priority date is the same priority date of the present application, i.e., May 20, 1998. Accordingly, as discussed below, the prior art rejections should be withdrawn.

Rejections under 35 U.S.C. § 101 as Claiming Same Invention As Stebbings, U.S. Patent No. 6,636,689

Claims 1-9, 12, 13, 16-23, 30-36 and 38-42 are rejected as claiming the same invention as claimed in U.S. 6,636,689 to David Stebbings. Applicant respectfully traverses this rejection.

Specifically, Stebbings U.S. Patent No. 6,636,689 does not **claim** the use/application of **modulation rules as in the present application**. Rather, Stebbings claims "detecting the modulation of the **at least one of said pit depth, pit width and pit track.**" Accordingly, Stebbings claims a distinct invention than that being claimed in the present application, which claims "modulation **rule**." The use of **modulation rules** is a distinct and separate design from the use of **physical modulation characteristics** of the pit depth, pit width and/or pit track, as claimed in Stebbings. We have included a claim comparison in the enclosed Attachment highlighting these differences.

For example, comparing Claim 1 of the present application with Claim 1 of Stebbings results in the following differentiators or differences:

Claim 1 – Present Application:

1. A method for authenticating at least one of a media and data stored on said media, in order to prevent at least one of piracy, unauthorized access and unauthorized copying of the data stored on said media, wherein said data stored on said media is modulated **via at least one modified modulation rule** to generate at least one authentication key or component thereof for authenticating at least one of said media and said data, said method comprising the steps of:

(a) reading the data from said media;

(b) detecting the modulation of the **at least one modified modulation rule** associated with the data;

(c) deriving an embedded authentication key or component thereof responsive to said detecting step (b);

(d) comparing the embedded authentication key or component thereof, to at least one authentication key or component thereof;

(e) authenticating the at least one of said media and said data responsive to said comparing step (d); and

(f) outputting said data as at least one of audio, video, audio data, video data and digital data substantially free of the modulation of the **at least one modified modulation rule.**

Claim 1 U.S. Patent 6,636,689:

1. A method for authenticating at least one of a media and data stored on said media, in order to prevent at least one of piracy, unauthorized access and unauthorized copying of the data stored on said media, wherein said media is modulated via **at least one of pit depth, pit width and pit track** comprising at least one authentication key or component thereof for authenticating whether at least one of said media and said data is authenticated, said method comprising the steps of:

(a) reading the data from said media;

(b) detecting the modulation of the **at least one of said pit depth, pit width and pit track;**

(c) deriving an embedded authentication key or component thereof responsive to said detecting step (b);

(d) comparing the embedded authentication key or component thereof to at least one authentication key or component thereof;

(e) authenticating at least one of said media and said data responsive to said comparing step (d); and

(f) outputting said data as at least one of audio, video, audio data, video data and digital data substantially free of the modulation of the **at least one of the pit depth, pit width and pit track.**

As stated by the Federal Circuit in ***Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.***, 784 F.2d 351, 228 USPQ 837, 840 (Fed. Cir. 1986) (per curiam) (quoting ***In re Vogel***, 422 F.2d 438, 441, 164 USPQ 619, 621–22 (C.C.P.A. 1970)):

> By "same invention" we mean identical subject matter. Thus the invention defined by a claim reciting "halogen" is not the same as that defined by a claim reciting "chlorine," because the former is broader than the latter. . . . **A good test, and probably the only objective test, for "same invention," is whether one of the claims would be literally infringed without literally infringing the other.** If it could be, the claims do not define identically the same invention.

In addition, the Federal Circuit in that same case also provided examples when same invention double patenting does not apply:

This body of CCPA law as represented in *Boylan, Walles, Taylor, Vogel*, and other cases, dealt with the "same invention" issue. Our predecessor court refused to find double patenting based, variously, **on differences in claimed subject matter** on different statutory classes; on the existence of non-infringing uses; on differences in the breadth of the claims; and on the absence of "cross-reading" (whether the claims of one patent can be infringed without infringing the other).

Accordingly, Applicant respectfully submits that the same invention double patenting should be withdrawn, and such action is earnestly requested. In addition, since Applicant previously filed a Terminal Disclaimer in connection with the present application, no issues with respect to obviousness type double patenting are present.

Rejections under 35 U.S.C. § 103(a) as being anticipated by Stebbings, U.S. Patent 6,636,689 and Further in View of Hogan, U.S. Patent No. 5,828,754

Claims 10, 24, and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable by Stebbings, U.S. Patent 6,636,689 and Further in View of Hogan, U.S. Patent No. 5,828,754. Applicant respectfully traverses this rejection.

Applicant would like to initially inform the Examiner that Stebbings (U.S. Patent Number 6,636,689) is not prior art under 35 U.S.C. 102(e) or 103(a) because Stebbings' earliest priority date is the same priority date of the present application, i.e., May 20, 1998.

Therefore, the Stebbings patent application is **not prior art** to the instant application.

Accordingly, for these reasons, Applicant respectfully requests withdrawal of this rejection.

CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicant reserves the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicant specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

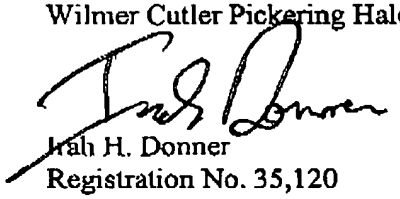
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

Wilmer Cutler Pickering Hale and Dorr LLP



Irah H. Donner
Registration No. 35,120

399 Park Avenue
New York, NY 10022
TEL (212) 230-8887
FAX (212) 230-8888

Date: 10/12/05

IHD/tes